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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,172	11/26/2003	James A. McEwan	27049-24	5747
23643	7590	09/21/2005		
BARNES & THORNBURG 11 SOUTH MERIDIAN INDIANAPOLIS, IN 46204			EXAMINER TRIEU, THAI BA	
			ART UNIT	PAPER NUMBER
			3748	
DATE MAILED: 09/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/723,172

Applicant(s)

MCEWAN, JAMES A.

Examiner

Thai-Ba Trieu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-20 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/361,612.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07/28/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The Office Action is in response to the Amendment filed on July 28, 2005 is acknowledged. Applicant's cooperation in correcting the informalities in the drawing and specification is appreciated. Applicant's cooperation in amending the claims to overcome the claim objections relating to informalities is also appreciated. Claims 1-8 and 10-12 were amended; claim 9 was cancelled; and claims 13-20 were newly added.

### *Claim Objections*

Claims **5** and **15-20** are objected because of the following minor informalities:

- In claim 5, line 1, "**41**" after "**as claimed in claim**" should be replaced by -- **1** --, since there is no claim 41 in the instant application.
- In claims 15-20, line 1, "**The apparatus as claimed in** " should be replaced by -- **The actuator as claimed in** -- (*for consistency*).

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 1 and its dependent claims 2-8; and claim 10 and its dependent claim 11-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- In claims 1 and 10, the recitation ***“at least one plane containing the axis of said elongate first portion”*** means that more than one plane can contain the axis of said elongate first portion. How can more than one plane contain this axis?

2. Claim 2 and claim 14 and its dependent claims 15-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains **new subject matter**, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically,

- In claims 2 and 14, the recitation ***“at least two orthogonal planes containing the axis of said elongate first portion”*** does not have any support in the original specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 1 and its dependent claims 3-8; claim 14 and its dependent claims 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically,

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- In claims 1 and 10, the recitation ***"at least one plane containing the axis of said elongate first portion"*** renders the claim indefinite, since it is not clear how many more planes can contain the axis of said elongate first portion. Applicant is required to clarify and explain these planes, which contain the axis of said elongate first portion.

- In claims 2 and 13-14, the recitation ***"at least two orthogonal planes containing the axis of said elongate first portion"*** renders the claim indefinite, since it is not clear that how the at least two orthogonal planes can contain the axis of said elongate first portion; as well as, such limitation does not have any antecedent basis in the original disclosure. Applicant is required to clarify and explain ***how the at least two orthogonal planes can contain the axis of said elongate first portion.***

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim **1** is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim **1** of U.S. Patent No. 6,658,846 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the patent anticipates application claim 1. Accordingly, application claim 1 is not patentably distinct from patent claim 1.

Patent claim 1 requires following elements:

- an actuator rod for a turbocharger pressure control assembly,
- the actuator comprising:
  1. a first elongate portion defining a first rod end,
  2. a second portion defining a second rod end,
  3. said first and second portions being pivotally joined to one another to allow a degree relative pivotal motion between said two portions in at least one plane perpendicular to the axis of said elongate first portion, and
  4. said second portion of the actuator rod being welded to said lever arm.

whereas, the instant application claim 1 required following elements:

- an actuator rod for a turbocharger pressure control assembly,
- the actuator comprising:
  1. a first elongate portion defining a first rod end,
  2. a second portion defining a second rod end, and
  3. said first and second portions being pivotally joined to one another to allow a degree relative pivotal motion between said two

portions in at least one plane containing the axis of said elongate first portion.

4. a lever arm fixedly connected to said second portion of actuator rod.

Thus it is apparent that the more specific patent claim 1 encompasses application claim 1. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. Note that since Application claim 1 anticipated by Patent claim 1 and since anticipation is the epitome of obviousness, then Application claim 1 is obvious over Patent claim 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claims 1-2, 5-8, 10, 12-14, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlamadinger (Patent number 4,159,815), in view of Yogo (Patent number 4,549,470).***

Schlamadinger discloses an actuator rod (25, I, II) for a turbocharger pressure control assembly, the actuator rod comprising a first portion (25 I, II) defining a first rod end, and a second portion (28) defining a second rod end, said first and second portions (25, I, II; and 28) being pivotally joined to one another to allow a degree of relative pivotal motion between said two portions in at least one plane containing the axis of said first portion; and in at least two orthogonal planes containing the axis of said first portion (26) (See Figures 2 and 4);

a pneumatic actuator (24) connected to said first rod end (See Figures 2 and 4);

the pneumatic actuator (24) comprising a spring loaded diaphragm housed within a pressure chamber (24b), the diaphragm (D) being attached to the first rod end ((25 I, II) (See Figures 2 and 4);

a valve assembly (V), end of said actuating rod being connected to said actuator and the other end being connected to the valve assembly, whereby the pneumatic actuator controls of the valve assembly via the actuator rod (25, I, II); the valve assembly (V) further comprising a lever arm (Not Numbered) extending from and connected to a valve (V), said second portion (28) of the actuator rod being secured to said lever arm extending from the valve assembly by way of which the valve is operated (See Figures 2 and 4).

However, Schlamadinger fails to disclose the first portion being elongated.



Yogo teaches that it is conventional in the linking mechanism art, to utilize the elongate first portion (14) (See Figures 1 and 2).

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized the elongate first portion, as taught by Yogo, to improve the control of the linear movement of the actuator in the smooth manner.

***Claims 3-4 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlamadinger (Patent number 4,159,815), in view of Yogo (Patent number 4,549,470), and further in view of Hauer (Patent Number 4,994,660).***

The modified Schlamadinger discloses the invention as recited above; however, fails to disclose the pivot joint being spherical; a socket defined by the other of said first and second portions to receive said spherical formation.

Hauer teaches that it is conventional in the linking mechanism art, to utilize the pivot joint being spherical (68); a socket defined by the other of said first and second portions to receive said spherical formation; a pneumatic actuator (70) connected to said first rod end (73) (See Figures 2 and 6, and Column 4, lines 36-40).

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized the pivot joint being spherical; a socket defined by the other of said first and second portions to receive said spherical formation; a pneumatic actuator connected to said first rod end, as taught by Hauer, to improve the performance of the joint in the modified Schlamadinger device.

***Allowable Subject Matter***

Claim 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed on July 28, 2005 have been fully considered but they are not persuasive. Accordingly, claims 1-7 and 10-20 are pending.

***Conclusion***

The IDS (PTO-1449) filed on July 28, 2005 has been considered. An initialized copy is attached hereto.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai-Ba Trieu whose telephone number is (571) 272-4867. The examiner can normally be reached on Monday - Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on (571) 272-4859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTB  
September 14, 2005

  
Thai-Ba Trieu  
Primary Examiner  
Art Unit 3748

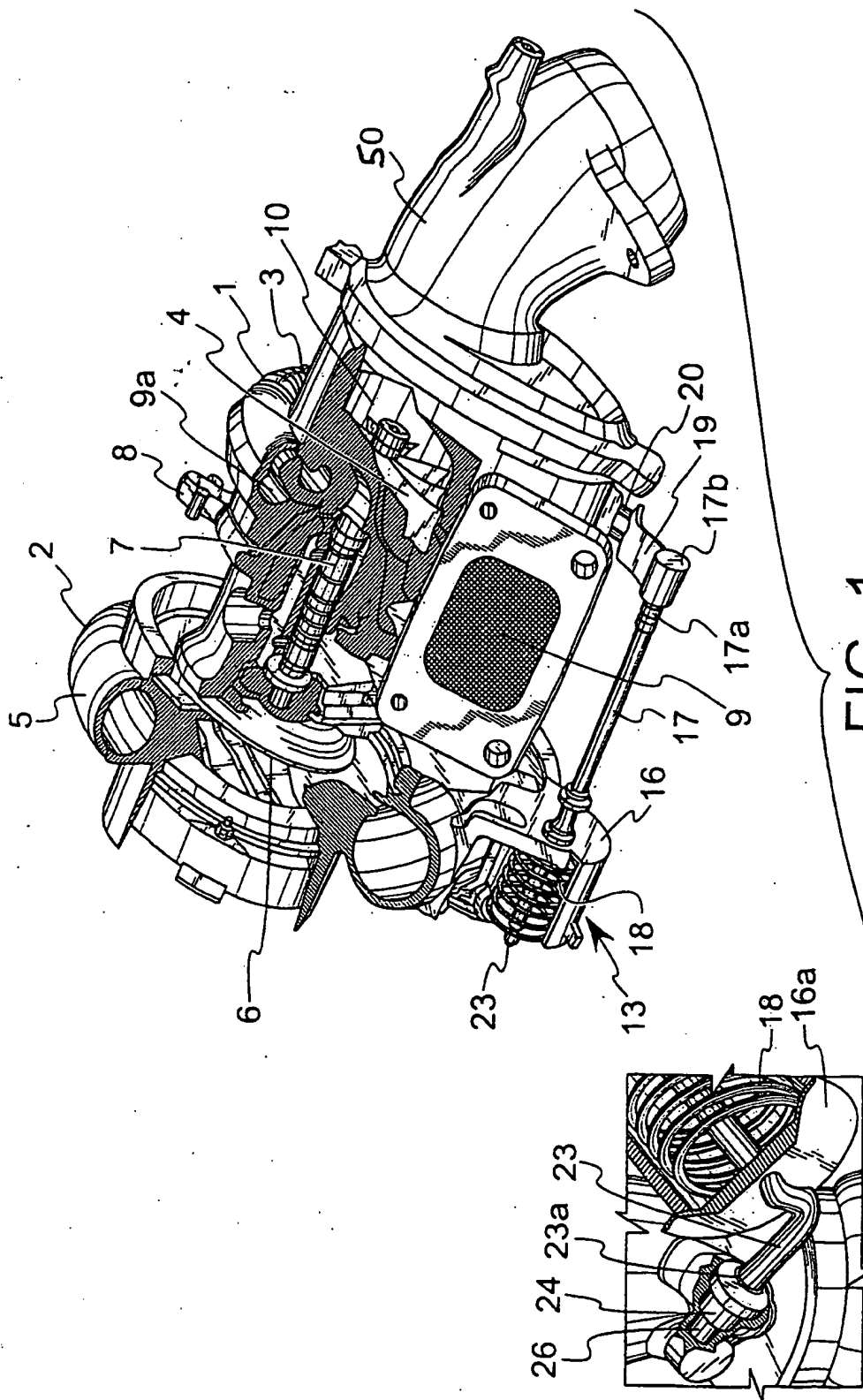


FIG. 1